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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,330	08/09/2000	Luis Eduardo Gutierrez-Sheris	Unisphere-13/2	5198

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NEW YORK, NY 10036

EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/635,330

Applicant(s)

GUTIERREZ-SHERIS, LUIS  
EDUARDO

Examiner

Stefano Karmis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This communication is in response to Applicant's amendment filed on June 2, 2003. The rejections are as stated below.

#### ***Status of Claims***

2. Claims 1-17 have been left as originally filed. Claims 18-23 have been added.

Therefore, claims 1-23 are under prosecution in this application.

#### ***Summary of this Office Action***

3. Applicants' amendment filed on June 2, 2003 have been fully considered, and discussed in the next section below or within the following rejection are not deemed to be persuasive. Therefore, claims 1-23 are rejected as being unpatentable over the art cited below, and Applicants' request for allowance is respectfully denied.

#### ***Response to Applicants' Amendment***

4. The Examiner acknowledges Applicant's arguments in the remarks with respect to the 37 C.F.R. § 1.131 affidavit and therefore withdraws the previous office action's claim rejection under 35 U.S.C. § 103. Any arguments with respect to the claims are considered moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al. (hereinafter Downing) U.S. Patent 5,963,647 in view of Risafi et al. (hereinafter Risafi) U.S. Patent 6,473,500.

Regarding claims 1, 8, 14 and 18, Downing teaches a system and method for transferring funds from a customer to a recipient comprising collecting a sum of money associated with a money-transfer company to be sent to a recipient (column 10, line 38 thru column 11, line 3), providing the recipient with a unique access code and reference number (column 7, lines 5-17) and the recipient uses a terminal to enter the reference number and secret code to obtain the transferred funds (column 7, lines 29-41).

Downing teaches that a recipient may access the system with respect to the transaction through a variety of means, including through a self-service terminal (ATM) with no requirement that the recipient even have a card to access the terminal (column 7, lines 18-28). Downing fails to teach the intermediate steps of receiving a money pick-up device from a distributor, and having that money pick-up device activated so that it may be used at a money-dispensing terminal.

Risafi teaches a system and method for using a prepaid card in which a recipient interacts with an agent distributing cards, the recipient selects a PIN, the card is then activated and the recipient may use it as a money-dispensing terminal (column 3, line 53 thru column 4, line 16). It would have been obvious at the time of the Applicant's invention to modify the teachings of Downing to include the use of distributors presenting cards to recipients to access money dispensing terminals because it allows for a standard system in which money acquiring cards are issued to be integrated with transferring funds from one individual to another and simply lets the distributor act as an intermediary.

Claims 2 and 9, Risafi teaches that the card activation step includes transmitting PIN from the distributor to the processing center, and then transmits another PIN from the processing center back to the distributor (column 4, line 61 thru column 5 line 10).

Claims 3 and 10, Risafi teaches sending unique device identification during the transmitting of the unique device pick-up code (column 4, line 61 thru column 5 line 10).

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Claims 4 and 11, Risafi teaches distributor identification is sent to the processing center (column 16, lines 11-32 and Figure 4).

Claims 5, 12 and 15, the step of transmitting the unique device pick-up code includes transmitting signals from the distributor to the processing center via a telephone network and the step of transmitting the distributor identification includes transmitting a number identification to the processing center (column 16, lines 11-32).

Claims 6, 13 and 16, activating the card requires that the number identification be matched prior to transmitting the PIN from the processing center back to the customer (column 16, lines 11-32).

Claims 7 and 17, Risafi teaches that the money dispensing machines are ATM machines and providing the recipient with a money pick-up device provides the recipient with an ATM card having a magnetic stripe (Figure 3) and personal identification number (column 6, lines 36-64).

Claims 19 and 20, Downing teaches identifying the beneficiary by the customer and requires a fund pick up number that is provided by the customer (column 6, lines 18-37 and column 7 lines 6-17).

Claim 21, Risafi teaches providing the recipient with a PIN after receipt of the fund pickup number by the distributor and the dispensing money step is carried out only

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upon receipt by the money dispensing machine of the personal code (column 6, line 38 thru column 7 line 18).

Claim 22, Risafi teaches supplying the activated card to the recipient (column 4, line 61 thru column 5, line 10).

Claim 23, Risafi teaches that the fund pickup number may be communicated between a recipient and a network of agents or distributors (column 3, line 53 thru column 4, line 16).

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Benton et al., US Patent 4,960,981 Oct. 2, 1990. Method and system for electronic funds transfer via facsimile machines.
- b) Marcous et al., US Patent 5,650,604 Jul. 22, 1997. System and method for electronic transfer of funds using an automated teller machine to dispense the transferred funds.
- c) Jennings et al., US Patent 5,659,165 Aug. 19, 1997. Customer-directed, automated process for transferring funds between accounts via a communications network.
- d) Jennings et al., US Patent 5,825,003 Oct. 20, 1998. Customer-directed, automated process for transferring funds between accounts using a holding account and local processing.
- e) Konya, US Patent 5,937,396 Aug. 10, 1999. System for ATM/ATM transfers.

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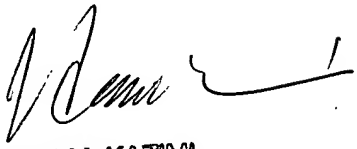
- f) Davis et al., US Patent 6,298,336 Oct. 2, 2001. Card activation at point of distribution.
- g) Ladd et al., US Patent 6,470,317 Oct. 22, 2002. Markup language to allow for billing of interactive services and methods thereof.
- h) Stoutenburg et al., US Patent 6,488,203 Dec. 3, 2002. Method and system for performing money transfer transactions.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.

Respectfully Submitted  
Stefano Karmis  
August 12, 2003

  
**HANI M. KAZIMI**  
**PRIMARY EXAMINER**